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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte SHIGEFUMI SAKAI, ATSUYUKI KIBA,
11 CHITOSHI SHIGENO and HIDEAKI KUBO
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14 Appeal 2007-1636
15 Application 09/892,577
16 Technology Center 1600
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19 Oral Hearing Held: Tuesday, January 15, 2008
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23 Before TONI R. SCHEINER, DEMETRA J. MILLS, and
24 ERIC B. GRIMES, *Administrative Patent Judges.*
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27 ON BEHALF OF THE APPELLANTS:
28

29

30 J. DEREK MASON, ESQ.
31 Oblon Spivak McClelland Maier & Neustadt P.C.
32 1940 Duke Street
33 Alexandria, Virginia 22314

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35 The above-entitled matter came on for hearing on Tuesday, January
36 15, 2008, commencing at 9:03 a.m., at the U.S. Patent and Trademark
37 Office, 600 Dulany Street, 9th floor, Hearing Room B, Alexandria, Virginia,
 before Laurie Andrews, Notary Public.

1 JUDGE SCHEINER: Good morning, Mr. Mason.

2 MR. MASON: Good morning. It looks like we are the only
3 shows in town today.

4 JUDGE SCHEINER: That is right. We had a couple of
5 postponements. You still only get 20 minutes.

6 MR. MASON: That's okay. Hopefully, we will only need 20.

7 JUDGE SCHEINER: Thank you. You can start whenever you
8 are ready. Would you like to introduce your colleague for the record?

9 MR. MASON: Yes. This is Mr. Niinaka. He is with Kao
10 Corporation, who is the assignee of the present case. He has come to
11 observe the hearing.

12 JUDGE SCHEINER: Good morning. Whenever you are
13 ready.

14 MR. MASON: May it please the Board, I'm here today to
15 discuss this hydrogel composition that we have in this case. Basically, we
16 have a composition that has hydrogel particles in an aqueous medium. The
17 aqueous medium is required to have a specific viscosity and a specific
18 gravity.

19 The importance of this has been argued throughout the case,
20 and it really relates to the ability to obtain a stably dispersed and
21 homogeneous dispersant of the particles in the medium.

22 In particular, what we are trying to achieve here is more
23 specifically set out in claim 51, but basically we want something where the
24 particles are sitting in the medium, they don't float and they don't precipitate.

1 We have provided during prosecution a picture, which you may
2 have seen. I don't know if it's actually in the image file or not. Basically,
3 this is the type composition we are talking about.

4 The examiner has basically stated that we are obvious and
5 combined three references for most of the claims and then with a couple of
6 the claims has added in a fourth.

7 The three references that the examiner has primarily used are
8 Delrieu, Noda, and Rosenstreich. If you look at these three references, there
9 is something rather startling, that they are completely different types of
10 compositions.

11 Delrieu is probably the closest to our invention and is properly
12 used as a primary reference, in that they do describe particles that resemble
13 ours, in that they have hydrogel particles. However, there is nothing in
14 Delrieu that talks about balancing the specific gravity and viscosity in order
15 to obtain this type of stable dispersion.

16 The examiner has tried to reach into Noda and Rosenstreich to
17 suggest these specific gravities and viscosities, but these compositions of the
18 two secondary references are completely different.

19 Noda contains a type of particle that is a micro-capsule,
20 basically, it's a shell that's filled with a component. We in our specification
21 have specifically excluded those types of particles. That is not what we are
22 after. Those give you a completely different type of composition.

23 Further, the examiner says that Noda teaches a viscosity that is
24 overlapping with our range, and then says well, there is also a teaching that
25 modifying specific gravity gives you improved dispersability.

1 The examiner then changes and says that relates to dispersity.
2 That's wrong. We have provided references that point out that dispersability
3 relates to the rate of dispersion. Rate of dispersion means how easy it is to
4 make two different liquids disperse in one another or two different
5 components.

6 It says nothing about the stability of the dispersion, and in fact,
7 probably the best example of this would be salad dressing, oil and vinegar.
8 You can very quickly disperse it, shake it up, you make a dispersion. Sit it
9 down, what happens? It separates. You don't get a stable dispersion.

10 We have a stable dispersion. These particles sit there. They
11 don't go up. They don't go down. They don't separate out. They stay.

12 That's an error that the examiner has made with respect to
13 Noda, in addition to the different type of particles that are being used.

14 Look at Rosenstreich. The examiner says Rosenstreich teaches
15 a viscosity and a specific gravity that overlap with your range. However,
16 Rosenstreich has no particles whatsoever. It is just a cosmetic lotion.

17 None of the references recognize the importance of balancing
18 the hydrogel particle with the viscosity and specific gravity of the solution in
19 order to get this stable dispersion. It's not described anywhere. It's not
20 taught anywhere.

21 I have trouble understanding how one looking at Delrieu is
22 going to start looking at two references with completely different types of
23 compositions in order to find a viscosity or specific gravity that you want to
24 use.

25 JUDGE GRIMES: But the composition of Delrieu and the
26 composition of Rosenstreich are both lotions, aren't they?

1 MR. MASON: Actually, if you look at Delrieu, they mention a
2 lotion, but they never describe making one. The only thing they describe is
3 that they make their particles, then they test their particles on crushability.

4 JUDGE GRIMES: The first line of the abstract starts "A
5 protective cosmetic particulate shell delivery system for a topically applied
6 active agent." That sounds a lot like a lotion to me.

7 My question is why would you need a different viscosity or
8 specific gravity for a lotion containing gel particles as compared to a lotion
9 like in Rosenstreich that doesn't?

10 MR. MASON: If you wanted to have those gel particles stably
11 dispersed and suspended in the medium, so that they didn't float or
12 precipitate, you would have to go for a particular balance of viscosity and a
13 specific gravity. If you get that wrong, you end up with a liquid medium
14 with gel particles on the bottom that have settled out, or gel particles that are
15 floating at the top.

16 JUDGE GRIMES: I guess my question is if the viscosity and
17 specific medium that are recited in your claims are the same as the viscosity
18 and a specific gravity you would use in a lotion anyway, then what
19 distinguishes the claims from what is suggested by the prior art?

20 MR. MASON: I would say it's the use of the hydrogel particles
21 in these particular ranges of viscosity and specific gravity, and if claim 33 is
22 then still a problem, if you look at claim 51, claim 51 requires it to be stably
23 dispersed -- I want to use the exact wording here -- stably dispersed and
24 suspended in the aqueous medium.

1 JUDGE SCHEINER: Does Delrieu say anything about -- I
2 understand Delrieu doesn't say anything about the specific gravity or the
3 viscosity, but does Delrieu say the particles are stably suspended?

4 MR. MASON: No, not to my knowledge. If you look at
5 Delrieu, they only mention that you can have a cosmetic formulation, at the
6 paragraph bridging columns 11 and 12, and they basically say that cosmetic
7 formulations, diluents or vehicles are compositions applied externally to the
8 skin, hair or nails. They include but are not limited to water and oil, oil and
9 water, in cream or lotion form, sunscreens, toners, astringents, facial make-
10 up's, powders and skin cleansing.

11 They have a very general paragraph there. They don't say
12 anything about how these beads are in the composition.

13 JUDGE SCHEINER: Okay.

14 MR. MASON: Basically, again, the examiner is essentially
15 taking the position that if I can find the limitation anywhere in the cosmetics
16 art, then it's obvious, I can combine the references and it's obvious.

17 I have to believe that even in light of KSR, that is not the
18 standard. There has to be some reason that you would go to that reference.
19 There has to be some logical underpinning for going over there and grabbing
20 that specific viscosity and specific gravity, even if you say it is still obvious.

21 JUDGE GRIMES: If you have a composition and your goal is
22 to make a lotion like Delrieu has, you have to have a certain amount of
23 viscosity in order to have it a lotion and not be a paste or a thin liquid. There
24 is a range of viscosity that is going to correspond to a lotion composition.

1 What I am asking, I guess, is why shouldn't we read
2 Rosenstreich as saying this is the viscosity and specific composition that you
3 need for a composition that is going to be in lotion form?

4 MR. MASON: Even if you say that, what would you then
5 expect by putting that viscosity into Delrieu?

6 JUDGE GRIMES: You would expect to get a lotion, I would
7 think.

8 MR. MASON: You would expect to get a lotion but there's no
9 expectation as to what happens to those particles. Are they going to be
10 stably dispersed? Are they going to be sitting on the top? Are they going to
11 be sitting on the bottom?

12 JUDGE GRIMES: I didn't understand you to be arguing that
13 you had unexpected results that would be evidence of non-obviousness.
14 You are not making an unexpected results argument, are you?

15 MR. MASON: Basically, at this point, I had taken the position
16 that the examiner doesn't have a *prima facie* case.

17 If you then say they do, then I would ask what would be
18 expected then, that you get a lotion that has particles in it, but what would be
19 happening with those particles, and that is where we are talking, we get this
20 ability to have it stably dispersed by having that balance of the type of
21 particle and the viscosity and specific gravity.

22 Again, claim 51 is drawn specifically to that requirement.

23 JUDGE SCHEINER: Is claim 51 argued separately in the
24 brief?

25 MR. MASON: Yes, I believe it was.

1 JUDGE GRIMES: Another question on a related topic. You
2 submitted a supplemental reply brief.

3 MR. MASON: Right.

4 JUDGE GRIMES: After the regular reply brief. What rule
5 would you cite as a basis for that being considered?

6 MR. MASON: I'm trying to remember exactly what the reason
7 for filing the supplemental reply brief was.

8 JUDGE GRIMES: It was filed more than two months after the
9 answer. As I understand our rules, that's the deadline.

10 MR. MASON: Which we had filed a reply brief.

11 JUDGE GRIMES: Correct. The examiner noted that he
12 considered that one, but he did not note or did not say anything about
13 considering the supplemental.

14 MR. MASON: Could I ask you to give me an idea of what it
15 was that was extra in the supplemental reply brief?

16 JUDGE GRIMES: I only took a quick look at it, but it looked
17 like there was a discussion of a reference that was mentioned by Noda.

18 MR. MASON: It basically relates to the improved
19 dispersability. Again, the term "dispersability" is not the same as the stable
20 dispersion or dispersity, which the examiner seems to have mixed those two
21 up.

22 We have argued that previously. This was supplemental
23 information to show why that was so. Also to show that the reference
24 mentioned in Noda as containing this information about changing specific
25 gravity to get a particular dispersability wasn't right. There's an error there.

26 It was additional information.

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1 As to what rule, I don't know that there is a specific rule to say
2 please admit this, other than please admit this.

3 JUDGE GRIMES: Okay. Thank you.

4 JUDGE SCHEINER: Do you have anything further?

5 JUDGE MILLS: No.

6 JUDGE SCHEINER: I don't have any other questions.

7 MR. MASON: Thank you.

8 JUDGE SCHEINER: Thank you for coming in.

9 (Whereupon, at 9:16 a.m., the hearing was concluded.)

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